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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|--------------------------|---------------------|------------------|
| 10/802,094 | 03/16/2004 | Hiroki Kitagawa | 82478-5900 | 4072 |
| 7590 11/14/2005 | | | | |
| Snell & Wilmer L.L.P. Suite 1200 1920 Main Street Irvine, CA 92614-7230 | | EXAMINER HO, BINH VAN | | |
| | | ART UNIT 2821 | | PAPER NUMBER |

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/802,094 | Applicant(s) KITAGAWA ET AL. | |
| | Examiner Binh V. Ho | Art Unit 2821 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 is/are allowed.
- 6) ☒ Claim(s) 14 and 17-20 is/are rejected.
- 7) ☐ Claim(s) 15-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a response to amendment filed 08/30/2005. The newly added claims 13-20 necessitate a new ground of rejection as discussed below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 18, line 6 recited "the first portion is in thermal communication with the choke coil" with does not appear to be in originally filed specification. Thus, the recitation must be treated as "new matter". However, if the applicant does not believe that this subject matter is "new matter", an appropriate explanation is required including pointing out where support for this subject matter can be found in the origin specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 14 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kominami (6,577,066 of record).

(Claim 14)

Kominami discloses in figure 1, a driving apparatus for driving a fluorescent lamp, comprising a substrate comprising a first surface (6a), a choke coil (7) coupled to the first surface; a switching device (8,9) coupled to the choke coil (7); and a smoothing capacitor (14) coupled to the switching device, wherein the smoothing capacitor is one of directly coupled to the choke coil and coupled proximate to the choke coil via at least one lead.

(Claim 17)

Kominami discloses in figure 1, the smoothing capacitor (14) being directly coupled to the choke coil (7).

(Claim 18)

Kominami discloses a driving apparatus for driving a fluorescent lamp (1), comprising a substrate (6) comprising a first surface (6a) and a second surface (6b), a choke coil (7) coupled to the first surface; and a switching device (8,9), wherein a first portion of the switching device is coupled to the first surface, and a second portion of the switching device is coupled to the second surface and the first portion is in thermal communication with the choke coil.

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(Claim 19)

Kominami discloses the first portion being a positive MOS-FET device (8,9) and the second portion is a negative MOS-FET device (8,9).

(Claim 20)

Kominami discloses the smoothing capacitor (14) being one of directly coupled to the choke coil (7) and coupled proximate to the choke coil via at least one lead.

Allowable Subject Matter

6. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is an examiner's statement of reasons for allowance:

The cited art of record fails to teach a driving apparatus for driving a fluorescent lamp using a high-frequency inverter method, the driving apparatus comprising a main body including a switching function and a lead portion elongated from the main body, wherein the entire main body of the switching device is oriented on the second main surface directly opposite the choke coil with the substrate therebetween and to be thermally coupled to the substrate, the switching device being a component of the high frequency inverter and being positioned in a power-supply path to the fluorescent lamp with a combination of all recitations as defined in claim 1. Therefore, claims 1-13 are presently allowed.

Response To The Arguments

8. With respect to claim 18, Applicant argues, in the amendment filed 08/30/2005, the prior art does not teach "the first portion is in thermal communication with the choke coil". However, this limitation is a new subject matter and has been rejected under 35 USC 112, 1st paragraph as discussed in paragraph 2 above.

Conclusion

9. Applicant's amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Inquiry

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh V. Ho whose telephone number is 571 272 8583. The examiner can normally be reached on M-F from 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don K. Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Primary Examiner

Binh V Ho
Examiner
Art Unit 2821

Binh Van Ho
11/03/2005